



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,956	08/27/2001	Suzette Iskander	30879.205485	5426

826 7590 06/05/2003

ALSTON & BIRD LLP
BANK OF AMERICA PLAZA
101 SOUTH TRYON STREET, SUITE 4000
CHARLOTTE, NC 28280-4000

EXAMINER

GRAY, JILL M

ART UNIT	PAPER NUMBER
----------	--------------

1774

DATE MAILED: 06/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

143-5

Office Action Summary

Application No.

09/939,956

Applicant(s)

ISKANDER, SUZETTE

Examiner

Jill M Gray

Art Unit

1774

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 March 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gupta in view of "WINGTACK" Hydrocarbon Resins product data sheet ("WINGTACK") for reasons of record.

Gupta teaches a cable comprising a conductor and a polymeric jacket surrounding said conductor and polyolefin adhesive bonding said conductor to said polymeric jacket as required by claims 13 and 31, and a cable comprising an inner conductor, a dielectric layer, an outer conductor and a polymeric jacket wherein an adhesive bonds said outer conductor and said polymer jacket as required by claims 26 and 27. See abstract, column 5, lines 46-54 and column 6, lines 21-14. The metal conductor can be copper per claim 23 (see Example 3) and the outer jacket can be polyethylene per claim 24 (see column 6, lines 31-32). Gupta teaches that typical adhesives are comprised of a copolymer of ethylene with an ethylenically unsaturated carboxylic acid such as acrylic acid (column 1, lines 55-62). In addition, Gupta teaches an adhesive system that can be more easily removed from the conductor (column 2, lines 46-48), said adhesive system comprising a silane compound and carrier such as polyethylene which may contain additives such as ethylene acrylic acid, tackifiers and

Art Unit: 1774

hindered phenols (as required by claims 2 and 14). See column 5, lines 6-17.

Moreover, Gupta teaches that suitable results have been achieved with a blend of a linear low-density polyethylene with an ethylene acrylic acid copolymer, as required by claims 1, 7-8, 19-20 and 29. See column 4, lines 58-66. Gupta is silent as to the inclusion of a resin derived from at least one unsaturated C5 hydrocarbon.

WINGTACK teaches resins based on C5 hydrocarbons which can be used as tackifiers. These resins can be derived from aromatic monomers or aliphatic monomers as required by claims 3-6, 12, 15-18, 30 and 33.

As set forth above, Gupta teaches that tackifiers can be added to his adhesive composition. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the composition of Gupta by including a commercially available tackifier such as WINGTACK, which is compatible with polyolefins and provides light color, low odor, low melt viscosity and excellent adhesive properties. Regarding claims 9-10 and 21-22, Gupta teaches in the examples compositions wherein the polyethylene and tackifier are present in amounts within applicants' range, further teaching at column 4, line 66 through column 5, line 1 that the presence of the silane compound allows lowered amounts of EEA to be used. This teaching would have provided a suggestion to the skilled artisan for reducing the amount of the copolymer in the adhesive composition. Furthermore, it is the position of the examiner that where the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation, and in particular, with the addition of known additives such as the hindered phenol compound. Also, it is an

Art Unit: 1774

established principle of law that a limitation merely with respect to proportion in a composition of matter or process will not support patentability unless such limitation is "critical" As to claim 28, this property would have been obvious to choose and determine commensurate with the desired properties of the resultant coaxial cable.

Response to Arguments

3. Applicant's arguments filed March 17, 2003 have been fully considered but they are not persuasive.

Applicants argue that Gupta and WINGTACK both fail to teach and suggest that the combination of a copolymer derived from ethylene and at least one monomer selected from the group consisting of acrylic acid, methacrylic acid, methyl acrylate and ethyl acrylate and a resin derived from at least one unsaturated C5 hydrocarbon monomer could be combined to provide the unexpected results set forth in the present application, further arguing that it was not expected that a tackifying adhesive such as a C5 hydrocarbon resin could be combined with an ethylene/ethylene copolymer adhesive to produce an adhesive that provides a residue that can easily be removed from the conductor surface.

The combined teachings of Gupta and WINGTACK suggest doing what applicants have done, namely, combining an ethylene/ethylene copolymer adhesive with an art recognized and commercially available tackifier, C5 hydrocarbon resin. Furthermore, Gupta, does in fact teach that his adhesive system can be more easily removed from the conductor so that better electrical properties are obtained where connector are installed thereby providing a suggestion as to what parameters where

Art Unit: 1774

critical. It is the examiner's position that the mere fact that the references relied upon by the examiner fail to evince an appreciation of the problem identified and solved by applicants, in the same manner as applicants, is not, standing alone, conclusive evidence of the nonobviousness of the claimed subject matter. In addition, if the evaluation of an invention as a whole is obvious, evidence of superior results does not preclude the finding of obviousness.

Applicants have not clearly identified that which they regard as their invention.

No claims are allowed.

Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 1774

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M Gray whose telephone number is 703.308.2381.


The examiner can normally be reached on 10:00-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly can be reached on 703.308.0449. The fax phone numbers for the organization where this application or proceeding is assigned are 703.305.5408 for regular communications and 703.305.3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703.308.0651.

Jill M Gray
Examiner
Art Unit 1774

CYNTHIA H. KELLY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1700


May 31, 2003

